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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Bertelo et al. :
Application No. 09/088,707 :
Filed: June 6, 1998 :
Attorney Docket No. FR-AM0939NP :

This is a decision on the petition under 37 CFR 1.137(a), filed August 16, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Facts:

A final Office action was mailed on January 6, 2004.

A reply was filed on June 2, 2004, along with a request for a two-month extension of time.

A review of the reply indicates that sections are illegible.

A review of the "Auto-Reply Facsimile Transmission" would have informed petitioner that at least the first page of the transmission was not entirely legible.

The application became abandoned on June 7, 2004.

An advisory action was mailed on July 9, 2004.

The advisory action indicated the existence of three problems:

- (1) illegibility,
- (2) errors in the specification, and
- (3) an improper claim for priority in the first sentence of the specification.

Analysis:

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."¹
The general question asked by the Office is: "Did petitioner act as a reasonable and prudent

¹ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

person in relation to his most important business?"² A lack of knowledge of, or failure to understand, a PTO rule, the content of the MPEP, or an Official Gazette notice will not constitute unavoidable delay.³

The Office acknowledges the advisory action was not mailed until after the end of the maximum extendable time for reply. It is regrettable that the Advisory Action was not mailed until the end of the statutory period set for response to the final Office action. However, it is clear from 37 CFR 1.116 that abandonment of an application is risked when an amendment after a final Office action is filed. Petitioner may not rely upon non-receipt of an advisory action to establish that the delay was unavoidable. In the instant case, the file record reveals that petitioner did not take appropriate action to ensure that a proper response be timely filed so as to prevent the application from becoming abandoned. A delay is not "unavoidable" when an applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. See MPEP 711.03(c)(III)(C)(2).

A delay is not rendered "unavoidable" due to the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.⁴

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$1,370 for a large entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form is enclosed for petitioner's convenience.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

² See *In re Mattullath*, 38 App. D.C. 497 (D.C. Cir. 1912).

³ See *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D. D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay); *Vincent v. Mossinghoff*, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D. D.C. 1985) (Plaintiffs, through their counsel's actions, **or their own**, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

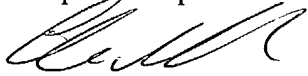
⁴ See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also *In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

By facsimile: (703) 872-9306
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Petitions Attorney
Office of Petitions

Attached: PTO/SB/64